

Remarks

Initially, Applicants note that this Office Action sets a three (3) month shortened statutory response period, instead of the usual one month reply period set to reply to a restriction requirement. Applicants are responding within one month of the date of the outstanding Office Action to expedite prosecution of this Application.

Election with traverse

In reply to the Election/Restriction Requirement, Applicants hereby elect, with traverse, the invention of Group I, the backlight unit for a display, claims 1-28.

Applicants traverse this requirement for several reasons.

Firstly, the Election/Restriction Requirement fails to correctly set forth which claims belong to the backlight unit for a display, and a liquid crystal display with a backlight. Claims 1-28 recite a backlight unit for a display device but none of these claims positively recites a liquid crystal display device. On the other hand, claims 29-38 positively recite a liquid crystal display device having a backlight unit.

Secondly, the Office Action has not demonstrated that there is any serious administrative burden on the Examiner to examine all pending claims, i.e., claims 1-38. MPEP §803 makes it clear that for a restriction to be proper, the

Examiner must show that (1) the claims are independent and distinct, and (2) there would be a serious burden on the Examiner if restriction is not required. However, at this stage of the prosecution, claims 1-38 have already been searched and examined on the merits. All that is left for the Examiner to do is update the search, which is to be expected at this stage of the prosecution.

Thirdly, the Office Action fails to provide any evidence that the combination claims, i.e., the claims directed to a liquid crystal display (LCD) with a shutter, do not require the particulars of the subcombination (the backlight unit). In this regard, all LCD claims positively recite specifics of the backlight unit. The statement in the rejection that the LCD in Group II does not require the backlight of Group I to function is not addressing the invention, as claimed, which is explicitly required by MPEP §806.05(c). Rather, this statement is addressing LCD's in general, which is not what is claimed. Additionally, the statement that the subcombination has separate utility so as to be used with any type of display is speculation without any objective factual evidence presented in support thereof. MPEP §806.05(f) requires that separate utility be shown, not just speculatively alleged, as is done here. Compare, in this regard, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Fourthly, Applicants have been put to the expense of replying, in an amendment filed on January 5, 2006, on the merits, under 37 CFR §1.111, to the Office Action dated October 5, 2005, which treats all claims, i.e., claims 1-38,

on their merits. This Office Action, which completely fails to respond to all of the arguments made by Applicants in the Amendment filed on April 13, 2004, is a prime example of piecemeal prosecution, which is inconsistent with "compact prosecution" advocated by the USPTO, is to be avoided in patent prosecution, and is fundamentally unfair to Applicants because it denies Applicants treatment of the arguments presented on the merits with respect to a large number of claims that were treated on their merits, and attempts to require Applicants to pay for filing and prosecuting a separate application. There is no serious administrative burden on the Examiner to examine all the claims.

For at least these reasons, the Election/Restriction Requirement is clearly improper and should be withdrawn, and the examiner is respectfully requested to examine all 38 pending claims on their merits.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Registration No. 46,472 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No.: 10/740,464
Art Unit 2875

Attorney Docket No. 0465-1061P
Reply to March 10, 2006 Office Action
Page 5 of 5

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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